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			EXAMINER
21186	7590	11/03/2005	RAMAKRISHNAIAH, MELUR

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ART UNIT	PAPER NUMBER
2643	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/955,510	HAYDUK, MATTHEW A.
	Examiner	Art Unit	
	Melur Ramakrishnaiah	2643	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5,7-16 and 18-27* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2, 4, 5, 7-16, 18-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____ .

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2.   Claims 13-14 are rejected under 35 U.S.C 102(e) as being anticipated by

Obradovich et al. (US 6,542,812, Provisional application No. 60/160,326, filed on

Oct. 19, 1999, hereinafter Obradovich).

Regarding claim 13, Obradovich discloses a mobile element, comprising:

a position monitoring module (119, fig. 1) capable of monitoring a position associated

with the mobile element (col. 4 lines 34-44), a first memory (108, fig. 1) including first

service preferences as shown in fig. 3, the memory capable of receiving second service

preferences determined by the position, and a comparator module (reads on processor

3) communicatively coupled to the memory to compare the first and second service

preferences (col. 4, line 64 – col. 5, line 46, col. 8 lines 30-38, col. 9 lines 35-55).

Regarding claim 14, Obradovich further teaches the following: a global

positioning receiver in (119, fig. 1) communicatively coupled to the position monitoring

module (119, col. 3 lines 31-35).

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 1-2, 4-5, 7-12, 16, 20, 22, 24, 25, 26, are rejected under 35 U.S.C. 103(a)

as being unpatentable over Obradovich et al. (US 6,542,812, Provisional application No.

60/160,326, filed on Oct. 19, 1999, hereinafter Obradovich) in view of Rautila et al. (US

PAT: 6,549,625, filed 6-24-1999, hereinafter Rautila).

Regarding claims 1, Obradovich discloses an application execution system,

comprising: a position monitoring module (119, fig. 1), a mobile element (120, fig. 1)

associated with a position capable of being monitored by the position monitoring module

(col. 3 lines 31-45, col. 4 lines 34-41), the mobile element having memory (108, fig. 1)

including a set of user service preferences including a first service preference (figs. 3-4,

col. 6, lines 8 –50), a service broadcaster (reads on 630, fig. 5) capable of being

communicatively coup0led to the mobile element (100, fig. 1) and broadcasting a

second service preference to the mobile element, and a comparator module (reads on

103) included in the mobile element to compare the first and second service

preferences, wherein favorites corresponding to profile is downloaded to the memory

(108) when the first and second service preferences are determined to be related by the

comparator module (col. 9 lines 35-54; figs. 3, 7).

Regarding claim 16, Obradovich discloses an apparatus, comprising: a processor (103, fig. 1), a memory (119, fig. 1) coupled to the processor for receiving a position and first service preferences (fig. 3) associated with the mobile elements, a memory coupled to the processor including a second service preference (figs. 3-4, col. 6, lines 8-50) associated with the position, and an application associated with the second service preference associated with the position, a list of favorites associated with the second service preference , wherein the list of favorites is downloaded to the mobile element when the second service preference is determined by the mobile element to be related to a first service preference stored in the mobile element (col. 3 lines 31-55; col. 9 lines 35-55).

Regarding claim 20, Obradovich discloses a method of executing an application, comprising: determining a position of a mobile terminal (fig. 1), selecting a second service preference associated with an application according to the position and a first service preference retained in the mobile elements (figs. 3-4, col. 6, lines 8-50, col. 3 lines 31-45), wherein the list of favorites is downloaded to the mobile element (100, fig. 1) upon mobile element determining that the first service preference is related to a second service preference (col. 9 lines 35-55).

Regarding claim 25, Obradovich discloses computer readable medium having program instructions stored therein for implementing, when executed by a digital processing device, a method for executing an application, the method comprising: determining position of a mobile element, and selecting a second service preference associated with an application according to position and first service preference retained

in the mobile element (col. 7 lines 3-41, col. 8 lines 30-59), wherein the list of favorites is

downloaded to the mobile element (100, fig. 1) upon mobile element determining that

the first service preference is related to a second service preference (col. 9 lines 35-55).

Obradovich differs from claims 1, 16, 20, and 25 in that he does not teach the

following: downloading the application to the mobile element.

However, Rautila discloses method and system for connecting a mobile terminal

to a database which teaches the following: downloading application to the memory for

execution by the mobile element (col. 5 lines 30-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time

invention was made to modify Obradovich's system to provide for the following:

downloading application to the memory for execution by the mobile element as this

arrangement would provide one of the methods, among many possible methods, of

providing application programs for the user to obtain information from servers as taught

by Rautila

Regarding claims 2, 4-5, 7-12, 22, 24, Obradovich further teaches the following:

position monitoring module includes a software program (implicit as the reference

teaches GPS receiver 119 to determine position, fig. 1, col. 6 lines 36-42), a global

positioning system receiver (119, fig. 1) communicatively coupled to the position

monitoring module (col. 6 lines 34-44), mobile element includes memory (108, fig. 1),

wherein the service broadcaster includes an application associated with second service

preference (col. 8, line 30 – col. 9, line 55), mobile element comprises a cellular phone

(col. 4 lines 34-44), second service preference comprises a hotel list file (215, fig. 3), plurality of list files related to the set of user preferences is broadcast to the mobile element (col. 8 lines 29-50), plurality of list files is formatted as a selection list (fig. 8, figs 13-14), wherein selection list includes a selected number of items determined by the position (col. 8 lines 34-38), storing the first service preference in the mobile element (fig. 3), wherein second service preference is hotel list file (215, fig. 3).

Regarding claim 7, Obradovich teaches the following: mobile element is a personal internet client (fig. 5 col. 7 lines 20-29).

Obradovich differs from claim 26 in that although it discloses application required to browse information obtained based on user service preferences and user profiles (col. 5 lines 1-33, col. 8 lines 29-50 of '812), he does not explicitly teach the following: downloading application to the memory for execution by the mobile element.

However, Rautila discloses method and system for connecting a mobile terminal to a database which teaches the following: downloading application to the memory for execution by the mobile element (col. 5 lines 30-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: downloading application to the memory for execution by the mobile element as this arrangement would provide one of the methods, among many possible methods, of providing application programs for the user to obtain information from servers as taught by Rautila

5.   Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over
Obradovich in view of Rautila.

Obradovich differs from claim 15 in that in that although he discloses application
required to browse information obtained based on user service preferences and user
profiles (col. 5 lines 1-33, col. 8 lines 29-50 of), he does not explicitly teach the
following: downloading application to the memory for execution by the mobile element.

However, Rautila discloses method and system for connecting a mobile terminal
to a database which teaches the following: downloading application to the memory for
execution by the mobile element (col. 5 lines 30-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time
invention was made to modify Obradovich's system to provide for the following:
downloading application to the memory for execution by the mobile element as this
arrangement would provide one of the methods, among many possible methods, of
providing application programs for the user to obtain information from servers as taught
by Rautila.

6.   Claims 18-19, 23 and 27 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Obradovich in view of Rautila as applied to claims 16, 20, 25 above,
and further in view of Masaki (EP 0883270 A1).

Regarding claim 18-19, 23 and 27, the combination does not teach the following:
a memory for receiving a set of capabilities associated with the mobile element, wherein
the application is not downloaded to the mobile element if the set of capabilities
associated with the mobile element is not in accordance with set of application

requirements associated with the application, sending a set of capabilities associated with the mobile element to the service broadcaster.

However, Masaki discloses distributed computing system which teaches the following: to provide a distributed computing system capable of providing, in a network environment with various terminals, an application service corresponding to processing capability of each terminal, a memory in (12, fig. 1) for receiving a set of capabilities associated with the communication terminals (col. 3 lines 51-56, figs. 12-13, col. 25 lines 31-41, col. 26 lines 27-56).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: a memory for receiving a set of capabilities associated with the mobile element, wherein the application is not downloaded to the mobile element if the set of capabilities associated with the mobile element is not in accordance with set of application requirements associated with the application, sending a set of capabilities associated with the mobile element to the service broadcaster as this arrangement would facilitate data transmission based on capability of the communication terminals connected to the data transmission system as taught by Masaki.

Response to Arguments

Regarding amended claims 1, 16, 20, 25, they are rejected under obviousness rejection as set forth above.

Regarding rejection of claim 13 as being anticipated by Obradovich, Applicant argues that "Obradovich does not teach or suggest a mobile element including "a

comparator coupled to the memory to compare the first and second service

preferences," as claimed by the Applicant in claim 13". Contrary to applicant's

interpretation of Obradovich with respect to this aspect, Obradovich discloses processor

(103) which does the comparison in order to select required user profile for obtaining

information from a server (630, fig. 5). For example fig. 7 illustrates preset profiles 1

through 6 corresponding to typical profiles "Man", "Woman", "Business Man", "Business

Woman", "Senior Woman", and "Teenager". Obradovich also teaches selecting a profile,

say for example for downloading information from a server (630). When user selects a

profile, processor (103, fig. 1) has to compare what user has selected with various user

profiles so that user can obtain information from a server based on user selection (col. 9

lines 35-52). So comparison is implicit in the processor in order to select required

profile to obtain information corresponding to selected profile.

103 Rejections of claims

Regarding rejection of independent claims 1, 13, 16, 20, and 25, Application

argues that "no combination suggested by the Office Action will render all of the claim

limitations. Obradovich does not discloses "a comparator module" included in the

mobile element (claims 1 and 13), or downloading an application, when second service

preference is determined by the mobile element to be related to a first service

preference stored in the mobile element" (claim 16), or upon the mobile element

determining that the first service preference is related to the second service preference"

(claims 20, 25) as claimed by the Applicant. Neither does Rautila or Masaki".

Regarding this, as explained above with respect to applicant's arguments regarding

(claim 13) comparator in mobile element, processor (103, fig. 1) acts as a comparator in

as much as user can select required profile among many preset user profiles for

downloading information from a server (630, fig. 16, col. 9 lines 35-55). This means:

When user selects a profile, processor (103, fig. 1) has to compare what user has

selected with various user profiles so that user can obtain information from a server

based on user selection corresponding to selected profile. While Obradovich teaches

downloading information from a server corresponding to user selected profile, it does

not teach downloading applications. However, Rautila teaches downloading

applications to user mobile phone (col. 5 lines 30-38). Therefore, the combination of

Obradovich and Rautila teaches the limitations of independent claims 1, 16, 20, 25 as

set forth in the office action. Therefore rejection of claims 1, 16, 20, 25 is maintained.

Applicant further argues no motivation to combine references. Applicant further

goes into dissertation of what references does teach or does not teach and argues that

they cannot be combined. In response to applicant's arguments against the references

individually, one cannot show nonobviousness by attacking references individually

where the rejections are based on combinations of references. See *In re Keller*, 642

F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231

USPQ 375 (Fed. Cir. 1986).

Applicant further ascribes motivations to combine references and alleges that it is

is based on unsupported assertions. Regarding this, In response to applicant's

argument that there is no suggestion to combine the references, the examiner

recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some

teaching, suggestion, or motivation to do so found either in the references themselves

or in the knowledge generally available to one of ordinary skill in the art. See In re Fine,

837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and In re Jones, 958 F.2d 347, 21

USPQ2d 1941 (Fed. Cir. 1992). In this case, for example regarding amended

independent claims 1, 16, 20, and 25, as set forth in the office action above, Obradovich

differs from claims 1, 16, 20, and 25 in that he does not teach downloading applications

to user mobile terminal where as Rautila teaches downloading applications to user

mobile terminal. The combination of Obradovich and Rautila teaches the limitations

amended independent claims 1, 16, 20, and 25 and motivation to combine references

is as given above: as this arrangement would provide one of the methods, among many

possible methods, of providing application programs for the user to obtain information

from servers as taught by Rautila. This motivation to combine the references above is

not unsupported as alleged by the applicant. But it is clearly taught by Rautila (col. 5

lines 30-38).

Applicant argues under "No reasonable Expectation of Success" that modifying

Obradovich to implement the application download capability of Rautila will not provide

a mobile element capable of determining the existence of related preferences. Neither

will combining Obradovich and Masaki. Further, both combinations are at odds with

determining the location of the mobile element". Regarding this, Obradovich teaches a

mobile element capable of determining the existence of related preferences such as

illustrated in figs 4, 7 and by selecting a profile, user can download information from a

server (630, fig. 5). However, Rautila teaches downloading applications to user mobile

terminal (col. 5 lines 30-38). So the combination of Obradovich and Rautila facilitate the

user to obtain application program for further use by a user as taught by Rautila.

Applicant further argues "The fact references can be combined or modified does

not render the resultant combination obvious unless the prior art also suggests the

desirability of the combination". In response to applicant's argument that there is no

suggestion to combine the references, the examiner recognizes that obviousness can

only be established by combining or modifying the teachings of the prior art to produce

the claimed invention where there is some teaching, suggestion, or motivation to do so

found either in the references themselves or in the knowledge generally available to one

of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir.

1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case,

for example, regarding amended independent claims 1, Obradovich teaches the

following such as a comparator module (reads on 103) included in the mobile element

to compare the first and second service preferences, wherein favorites corresponding to

profile is downloaded to the memory (108) when the first and second service

preferences are determined to be related by the comparator module (col. 9 lines 35-54;

figs. 3, 7) and Rautila teaches downloading application programs to mobile terminal

(col. 5 lines 30-38). One of ordinary skill in the art at the time invention was made

would be motivated to combine Obradovich with Rautila to obtain a system where it

would be possible to obtain more information from a server or database or for opening a

window by using downloaded applications as taught by Rautila.

In view of this rejection of claims 7, 15, 18-19, and 26-27 is maintained as set forth in the office action above.

7.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Melur Ramakrishnaiah
Primary Examiner
Art Unit 2643